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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,023	01/13/2004	Babu Mavunkel	219002029210	3276

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EXAMINER

HABTE, KAHSAY

ART UNIT PAPER NUMBER

1624

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/757,023

Applicant(s)

MAVUNKEL ET AL.

Examiner

Kahsay Habte, Ph. D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-21,23-26,28-32,35,36,39-53,55-57,59 and 60 is/are pending in the application.
- 4a) Of the above claim(s) 55-57,59 and 60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-21,23-26,28-32,35,36 and 39-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/17/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1, 3-21, 23-26, 28-32, 35-36, 39-53, 55-57 and 59-60 are pending in this application.

Election/Restriction

2. Applicant's election with traverse of Group I, Claims 1, 3-21, 23-26, 28-32, 35-36 and 39-53 drawn to piperazines where $L^1 = CO$, $L^2 = CH_2$ and $Ar^2 =$ aryl, 5-membered heteroaryl rings (see the first 9 heterocyclic rings in claim 9), pyridine, indole, benzothiophene, quinoline, isoquinolines and naphthyridine in a paper filed 8/5/2005 is acknowledged. Applicant's traverse the restriction requirement and argue that the office consider revising the restriction requirement i.e. change the restriction requirement to an election of species. The examiner disagrees with applicants. Note that restriction is optional. During a telephonic conversation with applicants on 5/9/2005, it was discussed the problems of searching the inventions in this case. Note that even with further restriction on the linkers (L^1 and L^2) and the heterocyclic ring Ar^2 , the invention is still too broad. Some of the variables or substituents are not defined e.g. fused aromatic or non-aromatic ring for the definition of Ar^1 , "non-interfering substituent" and "an isostere" for the definition of R^3 , "spacers" for the definition of Z, etc. Thus, restriction on this case is proper.

The requirement is still deemed proper and is therefore made FINAL.

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3. The claims are drawn to multiple inventions for reasons set forth in the restriction requirement. The claims are examined only to the extent that they read on the elected invention. Cancellation of the non-elected subject matter is recommended in response to this Office Action. Applicants have to recite specific rings for variable Ar^2 , define the linkers (i.e. $L^1 = CO$ and $L^2 = CH_2$) and also recite the "isosteres" and the "non-interfering substituents".

Abstract

4. The abstract is objected because it is more than a page. It is recommended that applicants shorten the abstract so that it fits in one page. The proviso and other details about the linkers are not important in the abstract.

Claim Objections

5. Claim 1 is objected to because of the following informalities: the claim limitations " Ar^1 bonded to L^2 and the atom of Ar^2 bonded to L^1 is no more than 24 angstroms" should read as " Ar^1 bonded to L^2 and the atom of Ar^2 bonded to L^1 is no more than 24 angstroms".

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claim 1, 3-21, 23-26, 28-32, 35-36 and 39-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

a. Claim 1 and claims dependent thereon are rejected because in claim 1 and elsewhere in the claims the phrase "non-interfering substituents" is not clear. What are considered as "non-interfering substituents" and what are not? What are the criteria for substituent to be non-interfering? It is recommended that applicants recite the "non-interfering" substituents to overcome this rejection.

b. In claim 1 and elsewhere in the claims, the phrase "W and X is spacer" is indefinite. What is covered and what is not? What is considered a spacer? It is recommended that applicants recite the spacers.

c. In claim 1 or elsewhere in the claims, the phrase "Y is COR³ or an isostere therefor" is not clear. What is an isostere? What is covered by isostere and what is not? According to page 11 of the specification, isosteres of CO and CH₂ include SO, SO₂ or CHOH. Is this what applicants intend? If so, they have to recite them in the claims.

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d. In claim 1, the phrase "Ar² is a substantially planar" is not clear. What does substantially planar mean? How is it different from unsubstantially planar? It is recommended that applicants delete "substantially planar" and recite the variable of Ar² as it was done in claim 9. Refer the restriction requirement for specific rings of Ar².

e. In claim 5, the phrase "Y is tetrazole; 1,2,3-triazole; 1,2,4-triazole; or imidazole" is improperly dependent on claim 4. Claim 5 depends from claim 4, but there is no mention of Y = tetrazole; 1,2,3-triazole; 1,2,4-triazole; or imidazole back in claim 4 or claim 1.

f. In claim 8, the term "comprising" is an open-ended language. It is required that applicants use the phrase "consisting of" instead.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Kahsay Habte', is positioned above the printed name.

Kahsay Habte, Ph. D.
Examiner
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KH
September 16, 2005